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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,045	08/07/2001	James W. Thackeray	40678-5C	6976

7590 06/25/2002

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EXAMINER

BARRECA, NICOLE M

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 06/25/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-8

Office Action Summary

Application No.

09/924,045

Applicant(s)

THACKERAY ET AL.

Examiner

Nicole M. Barreca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-46 and 58-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-46 and 58-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 6) ☐ Other:

DETAILED ACTION

1. Claims 43-46 and 58-65 are pending in this application.
2. The terminal disclaimer filed on 3/19/02 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 5,851,730 has been reviewed and is accepted. The terminal disclaimer has been recorded.
3. The objection to the abstract is withdrawn in response to the applicant's amendment.
4. The 35 U.S.C. 112, second paragraph rejections of claims 43, 44, and 54 are withdrawn in response to the applicant's amendments.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 56 and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 56 recites the limitation "the antireflective composition" in line 1. There is insufficient antecedent basis for this limitation in the claim. (Claim 54 recites "the antihalation composition".)

Claim 61 recites the limitation "the plasma gas" in line 1. There is insufficient antecedent basis for this limitation in the claim. (Should claim 61 depend on claim 60 instead of 58?)

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 54, 56 and 58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,261,743. Although the conflicting claims are not identical, they are not patentably distinct from each other because both recite methods comprising applying on a substrate a layer of antihalation (antireflective) composition comprising a thermal acid generator and an anthracene material (anthracenyl unit), applying a photoresist layer over the layer of antihalation (antireflective) composition, exposing the photoresist layer or activating radiation and developing the exposed photoresist.

9. Claims 54 and 58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11 or 24 of U.S. Patent No. 6,261,743. Although the conflicting claims are not identical, they are not patentably distinct from each other because both recite methods comprising applying on a substrate a layer of antihalation (antireflective) composition comprising an anthracene

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material (anthracenyl unit), applying a photoresist layer over the layer of antihalation (antireflective) composition, exposing the photoresist layer to activating radiation and developing the exposed photoresist.

10. Claims 54 and 58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,316,165. Although the conflicting claims are not identical, they are not patentably distinct from each other because both recite methods comprising applying on a substrate a layer of antihalation (antireflective) composition comprising an anthracene material (anthracenyl unit), applying a photoresist layer over the layer of antihalation (antireflective) composition, exposing the photoresist layer to activating radiation and developing the exposed photoresist.

11. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

12. Claims 43, 44 and 45 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 15 of copending Application No. 09/918,399. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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13. Claims 43 and 45 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 44 of copending Application No. 09/918,399. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jung (US Patent 6,368,768), filed 2/9/00, discloses an antireflective coating composition comprising an anthracene derivative.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole M. Barreca whose telephone number is 703-308-7968. The examiner can normally be reached on Monday-Thursday (8:00 am-6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

nmb
June 20, 2002


MARK F. HUFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700